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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,403	02/05/2004	Shinsuke Okada	P24588	3854
7055 7590 05/05/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER KASZTEJNA, MATTHEW JOHN				
ART UNIT 3730		PAPER NUMBER		
NOTIFICATION DATE 05/05/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

# Office Action Summary

**Application No.**

10/771,403

**Applicant(s)**

OKADA, SHINSUKE

**Examiner**

MATTHEW J. KASZTJEJNA

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 6-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2 and 6-23 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/28/8  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2009 has been entered.

### ***Notice of Amendment***

In response to the amendment filed on January 21, 2009, amended claims 1 and 10 and new claims 18-23 are acknowledged. The current rejections of the claims *are withdrawn*. The following new grounds of rejection are set forth:

### ***Claim Objections***

Claims 12-13, 18 and 22 objected to because of the following informalities: Each claim lacks the phrasing "wherein" or "further comprising" following the preamble of the claims. Thus, there is no connecting phrase after the preamble. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 6-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. The amendments to independent claims 1 and 10 with regard to claim language "movement of the alignment lens in the direction perpendicular to the optical axis alone adjusting an alignment of the entire plurality of lens elements assembled in the first lens unit" is unclear and indefinite. By reading the applicant's arguments filed January 21, 2009 it appears the applicant is attempting to claim that movement of the alignment lens alone in a direction perpendicularly to an optical axis performs an alignment of all of the plurality of lens elements of the first lens unit. This is unclear from the current claim language; however for purposes of expediting prosecution of the application, the claim will be examined as such.

Thus, it is unclear how movement of the alignment lens results in alignment of all the plurality of lens elements and the applicant states that it is only necessary to move the alignment lens in a perpendicular direction in order to achieve alignment of the entire plurality of all lens elements. Movement of the alignment lens 91a, does not result in alignment of the entire plurality of lens elements within lens barrel 92. As disclosed in the applicant's specification, paragraph 0077, "the worker drops the lenses of the objective optical system 91 one by one and in the lens barrel 92. During this procedure, the worker checks the positions of the lenses fitted in the lower portion of the lens barrel 92. If the lenses are fitted in wrong positions (i.e., positions different from the designed positions), the worker adjusts the positions of the lenses using the tweezers. Thus, the alignment lens is not used to achieve alignment of the entire plurality of lens elements, but rather is used to align the image with respect to the plurality of lens elements within lens barrel 92.

Claims 2, 6-9 and 11-23 are rejected as being dependant upon independent claims 1 and 10.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,590,721 to Onda in view of U.S. Patent No. 5,547,457 to Tsuyuki et al.

**In regards to claims 1-2, 6-8 and 10**, Onda discloses a first lens unit having a first lens barrel 1 and a first optical system including a plurality of lens 2, 3 elements assembled in said first lens barrel and aligned in a direction of a first common optical axis (see Fig. 1 and Col. 3, Lines 1-10) wherein said first lens unit includes an alignment lens 2 movable in a direction perpendicular to an optical axis thereof, movement of the alignment lens in the direction perpendicular to the optical axis alone adjusting an alignment of the entire plurality of lens elements assembled in the first lens unit (see Fig. 1), said first lens barrel being formed with a plurality of unthreaded holes 7 through which parts of a circumferential surface of said alignment lens are exposed (see Fig. 2), said alignment lens movably accommodated in said first lens barrel, and said alignment lens moved, in the direction perpendicular to the optical axis, by pins inserted through said plurality of holes, respectively (see Col. 4, Lines 1-20). Onda is silent with respect

to a second lens unit having a second lens barrel, engageable with said first lens barrel, and a second optical system including a plurality of lens elements aligned in a direction of a second common optical axis, and wherein, when the first lens barrel is engaged with the second lens barrel. Tsuyuki et al. disclose an analogous objective optical system configured to be implemented in a tip of an endoscope, comprising: a first lens unit having a first lens barrel 30 and a first optical system 29 including a plurality of lens L1, L2, L3 elements assembled in said first lens barrel and aligned in a direction of a first common optical axis; and a second lens unit having a second lens barrel 11, engageable with the first lens barrel, and a second optical system including a plurality of lens L4, L5 elements aligned in a direction of a second common optical axis, wherein, when the first lens barrel is engaged with the second lens barrel, the lens elements of the first and second lens barrels are aligned along a common axis, the first common axis and the second common axis comprising the common axis (see Figs. 5-6 and col. 8, Lines 18-67). **In regards to claims 9 and 11**, Tsuyuki et al. disclose an objective optical system, wherein the first lens barrel is attached to the second lens barrel by a screw connection (see Figs. 5-6 and Col. 8, Lines 59-64). It would have been obvious to one skilled in the art at the time the invention was made to modify the apparatus of Onda to include a second lens barrel having a second optical system and engagable with the first lens barrel to provide a plurality of lens components configured to permit adjusting a distance to an object to be observed as taught by Wilczynski et al.

**In regards to claims 12 and 15**, Onda discloses an optical system wherein the unthreaded holes been being configured to receive unthreaded pins that bear against the circumferential surface of the alignment lens (see Fig. 2 and Col. 1, Lines 20-35).

**In regards to claims 13-14, 16-17**, Onda discloses an optical system wherein a plurality of unthreaded holes are circumferentially spaced about the circumferential surface of the alignment lens (see Fig. 1 and Col. 3, Lines 10-30).

**In regards to claims 18-23**, Onda discloses an optical system wherein the unthreaded holes are sized so as to expose the parts of the circumferential surface of the alignment lens without exposing a portion of the circumferential surface of the plurality of lens elements of the first lens unit (see Fig .1).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2 and 6-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kasztejna/  
Examiner, Art Unit 3739

4/21/09